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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,367	08/15/2006	Robert Unglert	UNGLERT ET AL-2 PCT	6827
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COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			EXAMINER GRABOWSKI, KYLE ROBERT	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/589,367	Applicant(s) UNGLERT ET AL.	
	Examiner Kyle Grabowski	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/15/06, 10/04/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 32-36 are objected to because of the following informalities: claims 33-36 lack antecedent basis for the terms “imaginary virtual linear widening”, and “infinite width”. Heretofore, for examination on its merits, it will be construed that Claim 32 intended “imaginary virtual linear extension” to mean “imaginary virtual linear widening” and similarly for “infinite length” to mean “infinite width” to correspond with claims 33-36 which depend on it. Appropriate correction is required.

Claims 35 and 42 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 35 is an exact duplicate of claim 33 which it depends on; Claim 42 recites a “contraction of the label contour” which is synonymous with the recitation of a “narrowing of the label contour” in claim 41, from which it depends.

Claim 56 is objected to because of the following informalities: there is no antecedent basis for the term “the tangential direction”.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 46 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not mention a “detachable receipt section” nor is it depicted in any of the drawings; it is unclear where this section is located, what it is attached to, or how it detaches.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 36, 38, and 56, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 36 recites that the imaginary virtual linear widening of the first application part does not overlap the second application part wherein claim 35 from which claim 36 depends states that the imaginary virtual linear widening of the first application part overlaps the second application part. Claim 38 recites similar subject matter wherein the imaginary virtual linear extension of the first

application part does not overlap the second application part wherein claim 37 from which claim 38 depends states that the imaginary virtual linear extension of the first application part overlaps the second application part. It is unclear and indefinite whether or not an overlap region is present with the paradox encountered on claims 36 and 38.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 31-42, and 48, are rejected under 35 U.S.C. 102(b) as being anticipated by Weiss et al. (US 5,048,711).

In respect to claims 31, 39-42, and 48, Weiss et al. disclose a label 16 featuring a base layer with a first application part 24 and second application part 26 connected by a transition part 20 of reduced surface area (Fig. 4); the back of the label 16 includes adhesive which secures each application part 24 and 26 to its respective axially different cross-sections 14 and 12 (Col. 3, 23-24, Fig. 1); the base layer of label 16 includes lines of weakening 22 between the transition part 20 and the second

application part 26 (Fig. 1); the transition part 20 forms a narrowing/contraction of the label contour (Fig. 4);

In respect to claims 32-35, please refer to Figure 1x in the Appendix; Figure 1x is a representative outline of Figure 4 shown in Weiss et al. tilted 45 degrees upon application. In this orientation, an imaginary virtual linear widening of the first application part 26 that extends beyond the transition part 20 with infinite width (represented as 100) only overlaps second application part 24 partially, wherein the length of the overlapping region 200 does not exceeding $1/3^{\text{rd}}$ or $1/4^{\text{th}}$ the length of the either of the applications parts 24 or 26.

In respect to claim 36, please refer to Figure 2x in the Appendix; Figure 2x is a representative outline of Figure 4 shown in Weiss et al. with no added tilt. In this orientation, an imaginary virtual linear widening of the first application part 26 that extends beyond the transition part 20 with infinite width (represented as 100) does not overlap second application part 24.

In respect to claim 37, please refer to Figure 3x in the Appendix; Figure 3x is a representative outline of Figure 4 shown in Weiss et al. tilted 25 degrees. In this orientation, an imaginary virtual linear extension of the first application part 26 that extends beyond the transition part 20 with infinite width (represented as 100) overlaps second application part 24 partially.

In respect to claim 38, please refer to Figure 4x in the Appendix; Figure 4x is a representative outline of Figure 4 shown in Weiss et al. tilted 45 degrees. In this

orientation, an imaginary virtual linear extension of the first application part 26 that extends beyond the transition part 20 with infinite length (represented as 100) does not overlap second application part 24.

As shown in claims 32-38, the orientation (changing subjective traverse and longitudinal coordination) of the label and the demarcation of what constitutes the "transition portion" may be altered as suited for each claim.

7. Claims 31, 43, 44, 46, 47, 50, and 52, are rejected under 35 U.S.C. 102(b) as being anticipated by Kessler et al. (WO00/62848).

In respect to claims 31, 43, 44, 47, 50, and 52, Kessler et al. disclose a coaxial arrangement of two separable bodies: a nose cap 4 and syringe body 2; the transition between the bodies features a reduced cross-sectional dimension 9 (Fig. 2) on which a label 5 is placed thereon (Fig. 7); the label 5 features a base layer with a first application part 18 and a second application part 19, the application parts are connected by a transition part (28, 29, 30) which feature a reduced surface area owing to openings 27 (Fig. 8); the first application part 18 is fixed exclusively to the first body (syringe) 2 and the second application part 19 is fixed exclusively to the second body (nose cap) 4 (Fig. 7; Pg 8, Para 3); the rear side of the label 5 features an adhesive coating (Pg 8, Para 2); the label, which is transparent, includes printed information "TEXT" and a pull tab 32 (Pg 6, 'Brief Description of Drawings', Fig. 8).

In respect to claim 46, the second application part 19, which is detachable from body portion 18 along perforations 20, may act as a receipt which broadly means

something that is received; the removable application part 19 is capable of being received

8. Claims 31, 45, 50 and 53-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Frederiksen et al. (US 5,506,015).

In respect to claims 31, 45, 50 and 53-55, Frederiksen et al. disclose a coaxial arrangement comprising: a cylindrical region 28 and a conical region 29 which have different cross-sections at their transition which is sealed over by a label 10 (Fig. 5); the label has a first application part 13 and second application part 13 which are connected by transition part 14 of smaller surface area (Fig. 1); the bottom surface of the label 10 includes an adhesive 21 (Col. 3, 48-50); the first label part 13 is applied to the cylindrical region 28 while the second label part 13 is applied to the conical region 29 (Fig. 5); As evident in Figure 5, the diameters between the cylindrical region and conical region deviate from each other in a step-like fashion by at least 20% of the smaller conical region 29, and thereby at least 10% and at least 5% as well; the bottom layer 19 of the label may contain foil destructible materials (Col. 3, 46-48).

In respect to claims 56-60, Frederiksen et al. further disclose that “the seal [label] 10 is attached so that one enlarged contact section [first application part] 13 is positioned on the syringe [cylindrical region] 28 and the *remainder of seal [label]* 10 is wrapped around the syringe 28 and the needle cover [conical region] 29” (emphasis added) (Col. 4, 36-38, Fig. 5); this shows that the first application part 13 is first applied to the cylindrical region 28 (including both of its 'leading' and 'trailing' edges) and the

remainder of the seal, including the second application part (including both of its 'leading' and 'trailing' edges) is applied during wrapping of the remainder of the label.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss et al. (US 5,048,711) in view of Forg (US 2,904,474). Weiss et al. substantially discloses the claimed subject matter for the reasons stated above but does not disclose the label comprising a heat shrinking foil material. Forg discloses shrinking foil that is contracts a considerable extent under thermal influence (Col. 7, 43-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the label taught in Weiss et al. with a heat shrinking foil

in view of Forg to effectively contract and seal the label to a container. Furthermore it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kessler et al. (WO00/62848). Kessler et al. substantially disclose the claimed subject matter for the reasons stated above, including that the first application part 18 extends more than one-half the circumference of the first body 2 and that second application part 19 extend more than one-half the circumference of the second body 4 (Fig. 5) but do not specifically disclose that the transition part extends over less than one-fourth of the smaller of the two aforementioned circumferences; Kessler et al. do disclose, however, that the "size of the openings (27) have a direct influence on the force required to separate the cap portion (19) from the body portion (18)"; it can be inferred that the larger the openings 27, the smaller the surface area of the transition part (28, 29, 30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the openings 27 to create a transition part that extends less than one-fourth the circumference of the cap portion 19 (the smaller of the two main body circumferences) to directly influence the amount of opening force required to separate the cap portion and the body portion.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Braly (US 589,406), Carter (US 2,272,262), Rycroft (US 3,983,645), Kutcher (US 4,540,101), Muscala (US 4,758,456), and Gutt (US 5,257,704).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Grabowski whose telephone number is (571)270-3518. The examiner can normally be reached on Monday-Thursday, every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571)272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Derris H Banks/
Supervisory Patent Examiner, Art Unit 3725

/Kyle Grabowski/
Examiner, Art Unit 3725

Appendix

